



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Schwab et al

Serial No.: 08/822,397

Group No.: 2611

Filed: March 20, 1997

Examiner: R. Brown

For: VIDEO INPUT SWITCHING AND SIGNAL PROCESSING APPARATUS

H22
D. Lawson
6/9/04
103

APPELLANTS' REPLY BRIEF

RECEIVED

MAY 28 2004

Technology Center 2600

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is being filed in response to new points of argument raised by the Examiner in the Examiner's Answer mailed March 24, 2004.

Grouping of Claims

In the Examiner's Answer, the Examiner has reformulated the grouping of claims on the grounds that claims 18-25 recite subject matter different from claims 26-40. Accordingly, based upon the Examiner's election, the claims of this application as reciting patentably distinct subject matter for independent review by the Board:

Group I - Claims 18-25, wherein claims 19-25 stand or fall with claim 18;

Group II- Claims 26-40, wherein claims 27-40 stand or fall with claim 26.

Group I - wherein claims 19-25 stand or fall with claim 18

A careful reading of claim 18 will clearly demonstrate that the claims of this group are enabled under 35 U.S.C. §112, first paragraph. Claim 18 includes, *inter alia*, the steps of entering ... information regarding a view of preference; transmitting [and] receiving a TV program ... over a first transmission medium and "automatically switching a TV program to an alternate transmission medium

based on the information previously entered by the viewer without requiring any additional viewer intervention at the time of the switching.” Reference is again made to the specification, page 2 in particular, wherein a system controller is disclosed that “accepts signals from a standard infrared-type hand-held remote controller, handles such tasks as input selection and channel switching, and allows the user to reassign channel designations at will, even including input switching as part of the channel designation” (lines 20-25). Above this sentence, in the first full paragraph on page 2, “inputs” are defined as different types of broadcast media, including standard broadcast-frequency tuners, cable tuners, DBS tuners, and so forth. Thus, the step of “entering, at the viewer location, information regarding a viewer preference” is supported by the system controller handling certain tasks, such as allowing the user reassign channel designations at will. The step of “automatically switching the TV program to the alternate transmission medium based on the information previously entered by the viewer without requiring any additional viewer intervention at the time of the switching,” is clearly met by the disclosure of the system controller not only handles such tasks as input selection and channel switching, but even allows “input switching as part of the channel selection.” Thus, to anyone of skill in the art, this should be interpreted to mean that, based upon information previously entered by a user, when that user picks up the hand-held remote and changes the *channel*, a change of input may also automatically occur; that is, from cable to satellite, from broadcast to cable, and so forth. The other steps of the method do not appear to be contested, and it is well settled that, without disclosure regarding a particular order, the steps of a claimed may occur in whatever order is appropriate. Accordingly, the claims of this group are not only enabling, but they are allowable.

Group II - Claims 26-40, wherein claims 27-40 stand or fall with claim 26

With respect to claim 26, the Board is directed to the disclosure on the bottom of page 5 of the specification as filed, wherein it disclosed that

“a primary channel will typically carry ‘primary’ program information along with additional information used by the system for directing a second tuner to a secondary channel; other channels could be similarly associated. The information relating a primary channel to one or more secondary channels carrying supplemental information may be derived in various ways. For example, the primary channel may carry a pointer to the additional channel(s) ... retrace. Such a pointer may be carried more or less continuously by the primary channel” (lines 18-30).

Note, further, that reference is made in this passage to "tuners" and not just to "channels." Reference is further made to Figure 1, wherein different tuners are shown, *each one being associated with a different broadcast medium*. Conspicuously absent, at least in Figure 1, is multiple tuners associated with a single broadcast medium. Although the invention does not forego such possibilities, claims of this group set forth the embodiment wherein a pointer or other information on a particular channel may be used to select a different broadcast medium as part of an overall cohesive viewing environment.

In the Examiner's response to Appellants' argument, the Examiner certain "interpretations" and while these are not necessarily precluded by the instant invention, they represent embodiments that are narrower than in the claimed subject matter on appeal. For example, with respect to the portion of the specification found on page 3, lines 3-10, the Examiner advances the following interpretation:

"Each of the various inputs are enabled to support the stereoscopic technology, so that a primary channel will carry the 'left eye' signal, while the secondary channel carries the 'right eye' signal, with both the primary channel and secondary channel being received over the same transmission medium (i.e., input).

Where, Appellants ask, could the Examiner could possibly find support for "with both the primary channel and secondary channel being received over the same transmission medium (i.e., input)"? The reason why the Examiner had to *add this language*, is that the disclosure is not limited in that regard, but rather, to anyone of skill in the art, is directed to a system that can automatically change channels, transmission media, *or both*, either automatically using pointers found in a transmission, or through predefined user viewing criteria activated, for example, at the time the user changes channels.

Based upon the foregoing, Appellants submit that all claims continue to be enabled and allowable, seeks the Board's concurrence at this time.

Respectfully submitted,

By:

John G. Posa

Reg. No. 34,424

Gifford, Krass, Groh, Sprinkle,
Anderson & Citkowski, P.C.

280 N. Old Woodward, Suite 400

Birmingham, MI 48009

(734) 913-9300

Date: May 24, 2004